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EXAMINER

SMITH, RICHARD A

ART UNIT

PAPER NUMBER

2859

DATE MAILED: 03/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/735,851	Applicant(s) LARSSON, SVANTE	
	Examiner R. Alexander Smith	Art Unit 2859	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 January 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☒ Claim(s) 7-11 is/are allowed.
6) ☒ Claim(s) 1-3, 5 and 6 is/are rejected.
7) ☒ Claim(s) 4 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-3, 5 and 6 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. 5,961,220 to Som et al.

Som et al. discloses a device having a snap locking angle adjustable device (figures 1-4) comprising a first pivot member (2) and a second pivot member (1), rotatable relative to each other around a pivot axis (through 21); a first contacting element (8) having a first alignment structure (23 and 24) that rotates rigidly with the first pivot member around the pivot axis; a second contacting element (9) having complementary first alignment structure (column 3, lines 62+) that rotates rigidly with the second pivot member around the pivot axis; a spring (12) that, in conjunction with a spring expansion-restricting device (14 and 18), presses the first alignment structure axially against the complementary first alignment structure wherein the first alignment structure and the complementary first alignment structure align at certain angles between the pivot members, at which the spring force is reduced compared to at angles where they do not

Art Unit: 2859

spring expansion-restricting device comprises two position-limiting members (13-14 and 17-18), in between which the spring and the contacting elements are placed, rigidly held together by connecting structure, and each one of the contacting elements with its alignment structure is a single unit formed of plastic (column 3, lines 41-44), the first pivot member and the first contacting element are separate components joined to each other by structure (10 and 11) that rigidly connects these components with respect to rotations around the pivot axis, the second pivot member and the second contacting element are separate components joined to each other by structure (the second set of 10's and 11's) that rigidly connects these components with respect to rotations around the pivot axis.

Som et al. does not disclose said contacting elements with the respective alignment structure being formed by a moulding technique, the distance between position-limiting members can be changed by an axial screw coupling of the connecting structure, allowing for adjustment of the spring force, and the combination of a sleeve on one contacting element and a sleeve groove on a facing contacting element, aligns and secures the contacting elements and the pivot members on the pivot axis.

With respect to the contacting elements with the respective alignment structure being formed by a moulding technique: This limitation is a "product by process" limitation and is directed to a step required to form the contacting elements and the respective said alignment structure. Therefore, this step does not provide enough patentable weight since it has been held that 1) the determination of patentability in "product by process" claims is based on the product itself, even though such claims are limited and defined by the process, and 2) the product in a "product by process" claim is unpatentable if it is the same as, or obvious from a product of the

Art Unit: 2859

prior art, even if the prior art product was made by a different process. In re Thorpe et al., 227 USPQ 964 (Fed. Cir. 1985). Furthermore, as noted above Som et al. discloses these components are made from plastic.

With respect to claim 5, i.e., the distance between position-limiting members can be changed by an axial screw coupling of the connecting structure, allowing for adjustment of the spring force: In column 3, lines 44-55, Som et al. discloses that the spring is pre-compressed between shoulder 16 and the washer 17 and that the washer 17 is fixed by means of nut 18: Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to change the screw coupling of the connecting structure (at the nut 18) to allow adjusting of the spring force in order to pre-compress the spring sufficiently so that the device can be rotated into use position and storage position by hand as disclosed by Som et al. but not loose enough that the device will rotate out of storage unintentionally.

With respect to claim 6, i.e., the combination of a sleeve on one contacting element and a sleeve groove on a facing contacting element, aligns and secures the contacting elements and the pivot members on the pivot axis: Som et al. discloses in figure 3 for the above embodiment that a bushing 19 is used around one of the positioning-limiting members (bolt 13) and further discloses in figure 5 a different embodiment wherein one of the contacting elements include a sleeve 41 and the other includes a sleeve hole 42 wherein a groove is formed by said hole and by element 2 in order to seal the device from the environment. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use the sleeve and sleeve hole instead of a bushing, both as taught by Som et al., since Som et al. discloses that both can be used to seal the device from the environment and since the inclusion of the sleeve and hole

Art Unit: 2859

would reduce the number of parts needed in assembly. With respect to the applicant's sleeve groove being on a facing contacting element versus Som's being formed by the facing contacting element in combination with plate 2: The sleeve groove, as claimed by Applicant, is considered to be equivalent to the sleeve groove, as disclosed by Som et al., since: 1) neither non-obvious nor unexpected results, i.e., results which are different in kind and not in degree from the results of the prior art, will be obtained if one is used instead of the other, as long as the contacting elements are joined and properly sealed, as already taught Som et al.

The Applicant should note that the preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See In re Hirao, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and Kropa v. Robie, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

3. Claims 1-3 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. 4,620,658 to Hile in view of U.S. 4,097,999 to Nowlin.

Hile discloses an adjustable square having a snap locking angle adjustable device, comprising: a first pivot member (13) and a second pivot member (14), rotatable relative to each other around a pivot axis; a first contacting element (31) having a first alignment structure (35) that rotates rigidly with the first pivot member around the pivot axis; a second contacting element (25) having complementary first alignment structure (36-38) that rotates rigidly with the

Art Unit: 2859

second pivot member around the pivot axis; a spring (32) that, in conjunction with a spring expansion-restricting device (14 with 30 attached to 25; and 21, 31, 40 and 43), presses the first alignment structure axially against the complementary first alignment structure wherein the first alignment structure and the complementary first alignment structure align at certain angles between the pivot members, at which the spring force is reduced compared to at angles where they do not align, the spring expansion-restricting device comprises two position-limiting members (14 with 30 and 40) in between which the spring and the contacting elements are placed, rigidly held together by connecting structure, the first pivot member and the first contacting element are separate components joined to each other by structure that rigidly connects these components with respect to rotations around the pivot axis, the second pivot member and the second contacting element are separate components joined to each other by structure (column 2, lines 38-40) that rigidly connects these components with respect to rotations around the pivot axis.

Hile does not disclose each one of the contacting elements with its alignment structure is a single unit formed by a moulding technique.

Nowlin disclose an adjustable angle device wherein the preferred material is a resin like Lexan in order to obtain the required accuracy, to make the gauge light and durable, and to allow molding of the components (column 4, lines 54-63). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the square, taught by Hile, by forming the components included the contacting elements with its alignment structure from a molding technique, as taught by Nowlin, in order to obtain the required accuracy while keeping the square light and durable.

Art Unit: 2859

The Applicant should note that the preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See In re Hirao, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and Kropa v. Robie, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

4. Claim 5 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Hile and Nowlin as applied to claims 1-3 above, and further in view of U.S. 2,689,406 to Stormquist.

Hile and Nowlin together teach all that is claimed as discussed in the above rejections of claims 1-3 except for the distance between position-limiting members can be changed by an axial screw coupling of the connecting structure, allowing for adjustment of the spring force.

Stormquist discloses an angle device wherein a screw and an axial screw coupling (35) can be used for adjusting the spring force (column 3, lines 1-40) in order to allow quick adjustment based on the friction drag preferred and on the amount of tension needed for the usage including that for other instruments and tools. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the connecting structure, taught by Hile, to include an axial screw coupling, as suggested by Stormquist, in order to allow the user to adjust the friction drag as preferred.

Response to Arguments

5. Applicant's arguments filed January 6, 2005 with respect to Som et al. not teaching a square have been fully considered but they are not persuasive.

In response to applicant's argument with respect to Som et al. not teaching a square, the recitation has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). In this case, the limitations are drawn to a snap angle adjustable device with pivot structure for first and second pivot members and not to a pivot structure for a blade and a handle.

Allowable Subject Matter

6. Claims 7-11 are allowable.

7. Claim 4 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten to include all of the limitations of the base claim and any intervening claims.

Art Unit: 2859

8. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 2859

10. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The prior art cited in PTO-892 and not mentioned above disclose related squares and angle devices.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to R. Alexander Smith whose telephone number is 571-272-2251. The examiner can normally be reached on Monday through Friday from 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego F. Gutierrez can be reached on 571-272-2245. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'R. Alexander Smith', with a long, sweeping horizontal stroke extending to the right.

R. Alexander Smith
Patent Examiner
Technology Center 2800

RAS
March 16, 2005